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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054956
Party	Defendant Frederic Rambaud
Correspondence Address	FREDERIC RAMBAUS 153 LITTLE NOYACK PATH WATER MILL, NY 11976 UNITED STATES
Submission	Answer
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Date	01/25/2012
Attachments	pylones.answer.pdf (18 pages)(2894573 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----X)	
JACQUES HENRI FRANCOIS)	
GUILLEMET AND LENA)	
IRENE HIRZEL,)	
)	Cancellation No. 92054956
Petitioners,)	
)	Registration No. 3200271
v.)	
)	
ALAN CEPPOS AND)	
FREDERIC RAMBAUD,)	
)	
Respondents.)	
-----X)	

ANSWER TO PETITION FOR CANCELLATION

Respondents, Alan Ceppos and Frederic Rambaud (collectively, "Respondents") respond to the Petition for Cancellation filed by Jacques Henri Francois Guillemet and Lena Irene Hirzel (collectively, "Petitioners") as follows:

Respondents admit that they are the owners of U.S. Trademark Registration No. 3200271 dated January 23, 2007 for the mark PYLONES. Respondents lack knowledge or information sufficient to form a belief as to the truth of the remaining statements in Petitioners' introductory paragraph and on that basis deny these remaining statements.

1. Respondents admit the truth of the allegations in paragraph 1 of the Petition for Cancellation.
2. Respondents lack knowledge or information sufficient to form a belief as to

the truth of the allegations in paragraph 2 of the Petition for Cancellation, and on that basis, deny those allegations.

3. Respondents lack knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 3 of the Petition for Cancellation, and on that basis, deny those allegations.

4. Respondents lack knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 4 of the Petition for Cancellation, and on that basis, deny those allegations.

5. Respondents deny that Petitioners' website provides for sale or shipment of any merchandise to the United States. Respondents lack knowledge or information sufficient to form a belief as to the truth of the balance of the allegations in paragraph 5 of the Petition For Cancellation, and on that basis, deny those allegations.

6. Respondents deny the allegations in paragraph 6 of the Petition for Cancellation.

7. Respondents deny the allegations in paragraph 7 of the Petition for Cancellation.

8. Respondents deny the allegations in paragraph 8 of the Petition for Cancellation.

9. Respondents deny the allegations in paragraph 9 of the Petition for Cancellation, except admit that they opened a retail store under the name PYLONES in New York City in April, 2004 and that they subsequently opened six additional retail stores in New York City under the name PYLONES. Petitioners did not finance, supervise or otherwise control Respondents' retail operations.

10. Respondents deny the allegations in paragraph 10 of the Petition for Cancellation.

11. Respondents lack knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 11 of the Petition for Cancellation, and on that basis deny those allegations, except admit they filed an application to register PYLONES as a service mark with the U.S. Patent & Trademark Office on April 24, 2006 and that such application was assigned serial no. 76/658,991.

12. Respondents admit the truth of the allegations in paragraph 12 of the Petition for Cancellation.

13. Respondents admit the truth of the allegations in paragraph 13 of the Petition for Cancellation.

14. Respondents deny the allegations in paragraph 14 of the Petition for Cancellation, and state that by letter dated October 1, 2006, Jacques Guillemet, one of the Petitioners herein, as CEO of Pylones France, confirmed that Respondents' licensee, The Sarut Group, has exclusive "retail rights for all PYLONES products in the United States and Canada." A copy of the October 1, 2006 letter is attached hereto as Exhibit A.

15. Respondents deny the allegations in paragraph 15 of the Petition for Cancellation except admit that the Respondents' registered mark PYLONES is identical to Petitioner's pleaded trademark in sound and appearance. In their May 27, 2011 response to the trademark office action dated March 31, 2011 (the "Office Action Response"), Petitioners represented to the Trademark Office and admitted that Respondents were the Petitioners' "French supplier" and that "[b]ecause the Consenting

Party [ie, the Respondents] is authorized to distribute Applicants' goods in its gift shops, there can be no confusion." A copy of the Office Action Response and attached consent is annexed hereto as Exhibit B.

16. Respondents deny the allegations in paragraph 16 of the Petition for Cancellation.

17. Respondents deny the allegations in paragraph 17 of the Petition for Cancellation.

18. Respondents deny the allegations in paragraph 18 of the Petition for Cancellation.

19. Respondents deny the allegations in paragraph 19 of the Petition for Cancellation.

20. Respondents deny the allegations in paragraph 20 of the Petition for Cancellation.

AFFIRMATIVE DEFENSES

As affirmative defenses to the Petition for Cancellation, Respondents allege as follows:

1. The Petition for Cancellation fails to state a claim upon which relief can be granted.

2. Petitioners' claims in the Petition for Cancellation are barred under the doctrine of estoppel.

3. Petitioners' claims in the Petition for Cancellation are barred by waiver.

4. Petitioners' claims in the Petition for Cancellation are barred under the doctrine of acquiescence.

5. Petitioners' claims in the Petition for Cancellation are barred by laches.
6. As represented to the Trademark Office by Petitioners (paragraph 15, supra), there is no likelihood of confusion between Respondents' mark and Petitioners' mark.
7. Petitioners' forfeited any alleged trademark rights in the PYLONES mark due to their uncontrolled licensing of the mark.
8. By requesting Respondents' consent to Petitioners' trademark application, Petitioners admitted and acknowledged Respondents' prior rights in the mark, PYLONES, for retail services and Respondents' rights in their trademark registration for PYLONES in Class 35, and Petitioners are therefore estopped from asserting the claims in the Petition for Cancellation.

Dated: New York, New York
January 25, 2012

Respectfully submitted,

GORDON, HERLANDS, RANDOLPH
& COX LLP

By 

Peter J. Vranum, Esq.
355 Lexington Avenue
New York, New York 10017
(212) 986-1200

Attorneys for Respondents
ALAN CEPPOS AND FREDERIC RAMBAUD

CERTIFICATE OF SERVICE

I hereby certify that I caused a true copy of the foregoing Respondents' Answer to Petition for Cancellation to be served by First Class Mail, postage prepaid, on January 25, 2012, on:

Mark I. Peroff, Esq.
Hiscock & Barclay, LLP
Seven Times Square
New York, NY 10036



Peter J. Vranum

EXHIBIT A

PYLONES

41, avenue de l'agent Sarre
92700 COLOMBES
France

tél +33 1 56 83 81 11
fax +33 1 56 83 81 00
e-mail pylones@pylones.com

COLOMBES 1 October 2006

Dear Alan and Frederic,

This letter confirms that The Sarut Group has exclusive distribution and retail rights for all PYLONES products in the United States and Canada.

Jacques Guillemet
CEO
Pylones France

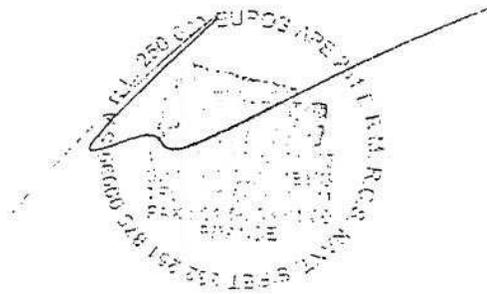


EXHIBIT B

Express Mail No. EM198031245US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark Application of
Jacques Henri François Guillemet and Léna
Irène Hirzel
Serial No: 79/071,877
Filed: January 20, 2009
Mark: PYLONES (Stylized)

Kristin M. Dahling
Examining Attorney
Law Office 113

Attorney Docket No.
266686-60001

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION

The Applicants, Jacques Henri François Guillemet and Léna Irène Hirzel ("Applicants") are in receipt of an Office Action dated March 31, 2011, and received in connection with Applicants' United States Trademark Application Serial No. 79/071,877 for PYLONES (Stylized). Applicants respectfully request the Examining Attorney reconsider and withdraw the refusal of registration based on the response below.

AMENDMENTS

Please delete the following goods from Applicants' identification of goods and services:

Radio transistors, in Class 9;



05-31-2011

U.S. Patent & TM/PT/TH Mail; Rpt. SL #01

CERTIFICATION UNDER 37 C.F.R. 1.10

I hereby certify that this paper is being deposited with the United States Postal Service as Express Mail, Label No. EM198031245US in the envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, on May 27, 2011.

Irene B. Tannen
(Name)

(Signature)

(Reg. No.)

May 27, 2011
(Date of Signature)

Electric toasters; hair-dryers; lamps, in Class 11; and
Trinkets and fobs, in Class 14.

ARGUMENT

In the Office Action dated March 31, 2011, the Examining Attorney maintains the refusal to register the mark PYLONES (Stylized) on the ground of likelihood of confusion based on the following registrations:

PYLON, Reg. No. 2,140,021, for "radon gas detectors and monitors; radon and thoron working level monitors; radiation detectors; electrical power supplies for telephones; power supplies, namely, DC converters, AC power converters, battery chargers, inverters, ringing generators, uninterruptible power supplies (UPS), key and private branch exchange (PBX) power supplies; cable assemblies; satellite communication equipment, namely, satellite and ground station monitors; sonar transducer impedance analyzers; multiplexors; water pollution detectors; and environmental monitors" in Class 9, in the name of Pylon Electronics, Inc.;

PILON, Reg. No. 3,190,107, for "electric coffee, espresso and cappuccino makers" in Class 11, in the name of Rowland Coffee Roasters, Inc.; and

PYLONES, Reg. No. 3,200,271, for "retail gift shops", in Class 35, in the name of Frederic Rambaud and Alan Ceppos.

Reg. No. 2,140, 021

With respect to Reg. No. 2,140, 021, PYLON, Applicants have deleted from their application the goods "radio transistors," which the Examining Attorney identified as being related to the goods covered by Reg. No. 2,140,021. Based on the deletion of

the aforementioned goods, it is requested that the Examining Attorney withdraw Reg. No. 2,140,021 as a basis for the refusal to register.

Reg. No. 3,190,107

In connection with Reg. No. 3,190,107, the Examining Attorney argues that Applicants' goods "toasters, lamps, and hair dryers" are closely related to the registrant's coffee makers. By the amendments made in this Response, Applicants have deleted those objectionable goods.

The Examining Attorney also notes that coffee makers are closely related to Applicants' services of "providing food and drink." In support of such a contention, the Examining Attorney argues that "coffee makers and providers of food and drink may consist of a single source as well, such as Starbucks." Applicants respectfully disagree that coffee makers and the services of providing food and drink have any relation, or that consumers of such different types of goods and services would believe them to emanate from the same source.

Applicants are unaware of any party that provides food and drink while also selling coffee makers under the same brand, including Starbucks. The Examining Attorney provided a print-out from the www.starbucks.com/business website for a "Starbucks Interactive Cup™ Brewer (ideal for 50+ employees)." However, it does not appear that such a "brewer" is actually sold by Starbucks (versus being available for rent or as a service), and the "brewer" is not available for direct purchase from the website shown in the Office Action attachment. Further, this "brewer" is offered in different trade channels to different customers than a typical coffee maker because it is

directed at businesses (“Starbucks Office Coffee”) rather than individual consumers to whom the Examiner is directing her arguments. This sizeable machine is also not a “small household appliance” as the Examining Attorney has described registrant’s goods.

Importantly, consumers would not understand the services of providing food and drink, offered under the PYLONES mark, to emanate from the source of PILON coffee makers. See, e.g., *Kangol Limited v. Kangaroos U.S.A., Inc.*, 974 F.2d 161, 163, 23 U.S.P.Q.2d 1945 (Fed. Cir. 1992) (“What is important is not whether people will necessarily confuse the marks, but whether the marks will be likely to confuse people into believing that the goods they are purchasing emanate from the same source.”). There is simply no possibility that consumers encountering Applicants’ services of providing food and drink would mistakenly believe such services come from the registrant, which sells coffee makers. There is no evidence that any party (aside from Starbucks, which Applicants dispute) sells coffee makers and also provides food and drinks under the same brand. There is also no evidence that third party registrations exist for a single mark registered for both coffee makers and services of providing food and drink, and Applicants could find no such registrations in a search of USPTO records.

The case of *In re Coors Brewing Co.*, 343 F.3d 1340 (Fed. Cir. 2003), in which the Federal Circuit held that the Board erred in determining that restaurant services and beer were related, is instructive. The Court found that the degree of overlap between the sources of restaurant services and the sources of beer was *de minimis*, and the tiny percentage of restaurants that also served as a source of beer was a “very weak

evidentiary basis for finding of relatedness." *Id.* at 1346-47. Here, there must be an even smaller percentage (if any) of parties that provide food and drink and sell coffee makers under the same mark. Thus, under the reasoning of *In re Coors Brewing*, the goods/services at issue should not be deemed related.

Based on the deletion of "toasters, lamps, and hair dryers" and the difference between coffee makers and Applicants' services, Applicants respectfully request the Examining Attorney withdraw Reg. No. 3,190,107 as a basis for the refusal to register the mark PYLONES (Stylized).

Reg. No. 3,200,271

Finally, as to Reg. No. 3,200,271 for PYLONES, Applicants submit herewith a letter of consent ("Consent") executed by Frederic Rambaud and Alan Ceppos, the record owners of Reg. No. 3,200,271 (hereinafter "Consenting Party"). The Consent is attached hereto as Exhibit A. Pursuant to the TMEP, "[a] consent agreement may be submitted by the applicant to overcome a refusal of registration under §2(d) of the Act, or in anticipation of a refusal to register." TMEP § 1207.01(d)(viii).

In the Consent, the Consenting Party agrees with Applicants' trademark filing in classes 3, 8, 9, 11, 14, 16, 17, 18, 20, 21, 24, 25, 28, 34, and 43. There will be no confusion resulting from Applicants' use of the PYLONES (Stylized) mark for the goods/services listed in the application and the Consenting Party's "retail gift shops" services because, as noted by the Consenting Party, Applicants are the "French supplier" for those shops. Because the Consenting Party is authorized to distribute Applicants' goods in its gift shops, there can be no confusion. Accordingly, the

Consenting Party provides consent for Applicants to use and register the PYLONES (Stylized) mark in connection with the goods and services in the present application.

As noted in the TMEP, the Court of Appeals for the Federal Circuit has determined "that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly dictate a finding of likelihood of confusion." TMEP § 1207.01(d)(viii) (citing *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Bongrain Int'l (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); and *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985)). See also *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1363, 177 USPQ 563, 568 (C.C.P.A. 1973) ("A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.")

Therefore, the Examining Attorney should give "great weight" to the Consent. TMEP § 1207.01(d)(viii). An examining attorney's own judgment regarding likelihood of confusion should not be interposed when there is a credible consent agreement, like the Consent. *Id.*

Given the Consent from the registrants of the PYLONES mark for "retail gift shops" and the fact that Applicants are the supplier for the registrants, Applicants respectfully request the Examining Attorney withdraw the refusal to register based on Reg. No. 3,200,271.

REMARKS

As the Examining Attorney will note, Applicants have amended the goods and services descriptions by deleting a number of goods which purport to overlap with the prior registrations cited in the Office Action. In addition, Applicants have deleted the goods "trinkets and fobs," which the Examining Attorney found to be indefinite. Applicants have also demonstrated that the subject mark PYLONES (Stylized) is not likely to cause confusion with the cited marks.

In view of the foregoing, Applicants believe that the PYLONES (Stylized) application is now in condition for publication. Applicants therefore respectfully request that the refusal to register Applicants' trademark PYLONES (Stylized) on the basis of Reg. Nos. 2,140,021; 3,190,107; and 3,200,271 be withdrawn and that the application proceed to publication.

Respectfully submitted,

JONES DAY

Dated: May 27, 2011

By: _____


Ilene B. Tannen
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New York, New York 10017
(212) 326-3939

Attorneys for Applicant
Jacques Henri François Guillemet
and Léna Irène Hirzel

A



Alan Ceppos
Frederic Rambaud
153 Little Noyac Path
Water Mill, N.Y. 11976

February 14, 2011

To Whom it May Concern,

We understand that our French supplier, PYLONES, has filed with the USPTO for a trademark under classes, 3,8,9,11,14,16,17,18,20,21,24,25,28,34, and 43 under the names of Mr. Jacques Henri Francois Guillemet and Ms. Lena Irene Hirzel, the Directors of Societe Pylones-France.

We confirm that we are completely in agreement with this filing in the classes mentioned above and we will not oppose nor contest this filing.

Alan Ceppos, American, born April 29th 1950 in New York and having 153 Little Noyac Path, Water Mill, N.Y. 11976 as principal residence.

Frederic Rambaud, French, born December 1, 1955 in Dakar, Senegal and having 153 Little Noyac Path, Water Mill, N.Y. 11976 as principal residence.

Alan Ceppos



Frederic Rambaud

